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In re Application of :
Michael C. Scroggie et al : DECISION ON PETITION UNDER
Application No. 09/756, 788 : 37 C.F.R. 1.181(a)(3) TO INVOKE
Filed: January 10, 2001 : SUPERVISORY AUTHORITY OF
Attorney Docket No.: CAT29US-SCRCO3 : THE DIRECTOR
For: SYSTEM AND METHOD FOR :
PROVIDING SHOPPING AIDS AND :
INCENTIVES TO CUSTOMERS :
THROUGH A COMPUTER NETWORK :

This is a decision on the petition under 37 CFR 1.181(a)(3) filed January 30, 2009, for withdrawal of the Notice of Non-Compliant Appeal Brief mailed January 26, 2008 and invocation of supervisory authority of the Director and for the transfer of the application to another examiner and to another SPE.

The petition is **GRANTED-IN-PART**, to the extent indicated below.

Petitioner alleges that the Notice of Non-Compliant Appeal Brief is improper.

The following citations from the MPEP and CFR are pertinent to this decision.

MPEP 1206. Amendments and Affidavits or Other Evidence Filed With or After Appeal.
(under section I):

See MPEP 714.02, 714.12 and 714.13 for the treatment of amendments, affidavits and other evidence submitted after the mailing of a final rejection or a non-final rejection, but prior to the filing of a notice of appeal under 37 CFR 41.31(a)(1)-(a)(3).

37 CFR 1.111. Reply by applicant or patent owner to a non-final Office action.

(a)

(1) *If the Office action after the first examination (§ 1.104) is adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply and request reconsideration or further examination, with or without amendment. See §§ 1.135 and 1.136 for time for reply to avoid abandonment.*

(2) *Supplemental replies. (i) A reply that is supplemental to a reply that is in compliance with § 1.111(b) will not be entered as a matter of right except as provided in*

paragraph (a)(2)(ii) of this section. The Office may enter a supplemental reply if the supplemental reply is clearly limited to:

- (A) Cancellation of a claim(s);
- (B) Adoption of the examiner suggestion(s);
- (C) Placement of the application in condition for allowance;
- (D) Reply to an Office requirement made after the first reply was filed;
- (E) Correction of informalities (e.g., typographical errors); or
- (F) Simplification of issues for appeal.

(ii) A supplemental reply will be entered if the supplemental reply is filed within the period during which action by the Office is suspended under § 1.103(a) or (c).

(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

MPEP 714.03

When a supplemental reply is filed in sufficient time to be entered into the application before the examiner considers the prior reply, the examiner may approve the entry of the supplemental reply if, after a cursory review, the examiner determines that the supplemental reply is limited to one of the situations set forth above. This list is not exhaustive. The examiner has the discretion to approve the entry of a supplemental reply that is not listed above. If a supplemental reply is a non-compliant amendment under 37 CFR 1.121 (see MPEP § 714), the supplemental reply will not be entered. If a supplemental reply is not approved for entry, the examiner should notify the applicant in the subsequent Office action. If applicant wishes to have a not-entered supplemental reply considered, applicant should include the changes in a reply filed in response to the next Office action. Applicant cannot simply request for its entry in the subsequent reply.

37 CFR 41.31. Appeal to Board.

(a) Who may appeal and how to file an appeal. (1) Every applicant, any of whose claims has been twice rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § 41.20(b)(1) within the time period provided under § 1.134 of this title for reply.

37 CFR 41.37. Appeal brief.

(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

...
(vi) Grounds of rejection to be reviewed on appeal . A concise statement of each ground of rejection presented for review.

...
(viii) Claims appendix . An appendix containing a copy of the claims involved in the appeal.

The reply filed September 29, 2008 was fully responsive to the September 17, 2008 non-final rejection and in compliance with 37 CFR 1.111(b). Accordingly it was a proper reply. The Petitioner is correct that an appeal can be filed once any claim has been twice rejected. At least claim 32 has been twice rejected. Once at least one claim has been twice rejected, a notice of appeal is considered to be a proper reply. Since the notice of appeal was, at the time of filing, the 2nd reply, it was considered a supplemental reply under 37 CFR 1.111(a)(2), which "will not be entered as a matter of right except as provided in paragraph (a)(2)(ii)" of 37 CFR 1.111. 37 CFR 1.111(a)(2) (A)-(F) provides for instances when the Office may enter a supplemental reply. The notice of appeal did not meet any of the instances set forth in (A)-(E). Furthermore, it was not limited to "(F) Simplification of issues for appeal". Accordingly, it was within the examiner's discretion not to enter the notice of appeal as it is a supplemental reply not meeting the requirements of (A)-(F) indicated above. The notice of appeal should have been filed in response to the next Office action as set forth in MPEP 714.03. Since the October 23, 2008 notice of appeal was not entered, the October 23, 2008 appeal brief was premature.

Petitioner further "elects to proceed with the appeal brief filed 17 October 2006, without updating the appeal brief." Applicant's request is not granted. In reply to the October 17, 2006 appeal brief, the examiner reopened prosecution and issued a non-final Office action on September 17, 2008. Accordingly, the issues set forth in the October 17, 2006 appeal brief are no longer pending.

With regards to the October 23, 2008 appeal brief itself... 37 CFR 41.37 requires that the brief contain, under section (vi) Grounds of rejection to be reviewed on appeal, a concise statement of each ground of rejection presented for review, and, under section (viii) Claims appendix, an appendix containing a copy of the claims involved in the appeal. The claims involved in the appeal are the claims commensurate in scope to the rejection set forth in section (vi) of the brief. The claims listed in the Claims appendix, do not contain a copy of the claims involved in the appeal since they are not the claims which were last rejected prior to the appeal brief (Claims 32-91). Accordingly, the brief filed is defective as it does not contain a copy of the appealed claims (i.e., the claims which was subject to the rejection).

In the petition, on page 8, third full paragraph under III. A. beginning "Fact 32, comment 36 on rule 41.31..." the Petitioner states "[t]his example clearly an [sic] unequivocally means that, if the applicant does file an amendment and an appeal, and both are within the time for responding to the office action, then the appeal is proper." The Petitioner is making a conclusionary

statement not supported by facts (e.g., MPEP or CFR citations). The appeal is a proper reply filed within the time period provided under 37 CFR 1.134; however it is a supplemental reply which was not be entered as a first proper reply had already been timely filed within the time period provided under 37 CFR 1.134 and which said supplemental reply does not fall under any of the instances set forth in (A)-(F) outlined above.

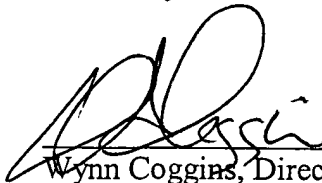
With respect to the Petitioner's concern over the handling of this application, a review of the entire record fails to reveal any conspiracy or "dirty tricks" of any kind on the part of the examiner or Supervisor. While there have been five office actions issued in the application, it is noted only the last two were issued by the current examiner, the first of which was a restriction/election requirement. Thus, the current examiner has only issued one action containing a prior art rejection of the claims. A review of the file history does not display any issues that would prevent the applicant from receiving a fair examination of the invention. Nor is there any evidence of any arbitrary or capricious actions on the part of the examiner assigned to examine the application. Therefore, the applicant's request to transfer the application is **DENIED**.

Since the Notice of Appeal and the Appeal Brief filed on October 23, 2008 were not entered, the examiner erred in sending out the January 26, 2009 Notification of Non-Compliant Appeal Brief. Petitioner's request to withdraw the Notice of Non-Compliant Appeal Brief is **GRANTED**. Accordingly, the Notice is hereby withdrawn

The Petitioner's request for the examiner to issue a response on the merits to the Appeal Brief filed October 17, 2006 will not be granted, as noted above. The Petitioner's request to remove the examiner and SPE will not be granted. Accordingly, the application is being forwarded to the examiner for consideration of the September 29, 2008 amendment. An Office action will be mailed in due course. Applicant may then file a notice of appeal.

If the Petitioner desires further review of this decision, then applicant should consider filing a Petition for Review of the Technology Center Director's Decision. The Office of the Deputy Commissioner for Patent Examination Policy has decision-making authority over any such petition. MPEP § 1002.02(b)(15)

Summary: *Petition Granted-in-Part*


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JWM: 4/2/2009

12